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REMARKS:

- 1) Referring to item 10) of the Office Action Summary, please indicate the acceptance of the drawings filed on April 15, 2004.
- 2) It is noted that both the elected claims 24 to 41 and the non-elected claims 42 to 47 have been examined. New claim 48 is also directed to the elected sub-combination invention.
- 3) The claims have been amended as follows. Claim 24 has been amended to make clear that the data input and the data output of the portable handheld device are configured, arranged and adapted to communicate with both the data processing device of the motor vehicle as well as the data input/output terminal that is external and separate from the motor vehicle. This clarification merely emphasizes a feature of original claim 24, and does not introduce any new matter. The dependency back-reference of claim 37 has been revised. New independent claim 48 has been added, based on a combination of prior claims 24 and 37. Thus, claim 48 does not introduce any new matter. Entry and consideration of the claim amendments and the new claim are respectfully requested.
- 4) Before addressing the prior art rejections and comparing the claimed features of the invention to the prior art, the invention will first be discussed in general terms to provide a background.

The present invention is directed to a portable handheld device that includes a portable authorization device (such as a

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key) that is required for enabling operation of a motor vehicle, and a portable data exchange device that is incorporated in the portable authorization device. The portable data exchange device includes a data memory connected to a data input and a data output, which are configured arranged and adapted to communicate with both a data processing device of the motor vehicle and a data input/output terminal that is external and separate from the motor vehicle.

It is significant that the portable handheld device combines four important features according to the invention:

- A) The portable handheld device incorporates a portable data exchange device within a portable authorization device.
- B) The portable authorization device authorizes the operation of a motor vehicle (e.g. in the manner of a key).
- C) The portable data exchange device communicates with a data processing device of the motor vehicle (particularly, the portable data exchange device includes a data input and a data output that are configured, arranged and adapted to communicate with the data processing device of the motor vehicle).
- D) The portable data exchange device further communicates with a data input/output terminal that is external and separate from the motor vehicle (particularly, the data input and the data output of the portable data exchange device are configured, arranged and adapted

to communicate with the separate external data input/output terminal).

Thus, the portable handheld device not only serves to authorize use of the motor vehicle, but also serves as a data carrier and a data exchange interface between the data processing device of the motor vehicle and the separate external data input/output terminal. The user of the portable handheld device thus has a convenient, simple-to-use, single device (such as a handheld key) that authorizes his use of the motor vehicle, and serves as an intermediate data carrier and communication interface between the motor vehicle's computer and the separate external data terminal. There does not need to be a direct communication between the motor vehicle's computer and the separate external data terminal, because the portable handheld device provides the communication interface and the data transfer between these two separate data processing systems. The user does not need to carry out any special additional procedures, but simply uses his vehicle key in the normal manner. While the key is used in the normal manner to provide authorization for operation of the motor vehicle, a data exchange can simultaneously be carried out. The interface provided by the portable handheld device further ensures compatibility between the motor vehicle's computer and the external data terminal, for example despite changes in these systems over time.

Present independent claim 24 specifically requires that the data input and the data output of the portable data exchange device incorporated in the authorization device must be configured, arranged and adapted to communicate with both the

onboard data processing device of the motor vehicle as well as the external data input/output terminal that is external and separate from the motor vehicle. Claim 24 thereby defines the feature of the portable handheld device being an intermediate interface for the data exchange between the onboard computer of the vehicle and the separate external data terminal.

These features are not disclosed and would not have been suggested by the prior art, as will be discussed below.

- 5) Referring to pages 2 to 3 of the Office Action, the rejection of claims "24 - 27, 29 - 33, 36, 38 - 40, 45 - 47" as anticipated by US Patent 5,254,996 (Claar et al.) apparently also applies to claims 28, 41 and 42, based on the detailed text of the rejection. This rejection is respectfully traversed.
- 6) As generally discussed above, present independent claim 24 is directed to a portable handheld device that incorporates a portable data exchange device within a portable authorization device. The authorization device enables operation of a motor vehicle, for example in the manner of an ignition key for the motor vehicle. The portable data exchange device includes a data memory as well as a data input and a data output connected to the data memory. The data input and the data output must be configured, arranged and adapted to communicate with both a data processing device of the motor vehicle as well as a data input/output terminal that is external and separate from the motor vehicle. In other words, the portable handheld device must serve to authorize use of the vehicle, and must provide a data

exchange interface for communication with both the motor vehicle's onboard computer as well as the separate external data input/output terminal. Claar et al. do not disclose a portable handheld device having such features.

- 7) Claar et al. disclose an arrangement for monitoring the charge status of a portable handheld device for a remote control system. In the embodiments of Figs. 1, 2 and 3, the portable handheld device is constructed as a card (1) that can be inserted into a receptacle (5), which may be provided in a motor vehicle. The card carries a current storage device or battery (3) connected to contacts (7). The card further carries a code memory (CS) and a signal emitter or output (4) in the embodiment of Figs. 1 and 2. The embodiment of Fig. 3 does not include the contacts (7). The card or handheld device further includes a transmit key or button (2) that can be depressed to initiate the transmission of a signal from the output (4). The embodiment of Fig. 4 includes a signal input (17) in addition to the signal output (4), the transmit button (2) and the battery (3), but is not disclosed as including the code memory (CS) or the contacts (7) connected to the battery (3). The system further includes a charge monitoring device (8) that tests or monitors the charge state of the battery (3) of the portable handheld device. In Figs. 1 and 2, that is achieved by measuring the voltage across the battery contacts (7). In Figs. 3 and 4, that is achieved by measuring the intensity of IR output from the transmission output (4). In Figs. 1 and 3, the signal emitted by the output (4) is also used

to control an on-board system, such as an anti-theft device (DS) in the motor vehicle.

- 8) No embodiment of Claar et al. has all the features of the invention.

In comparison to present claim 24, the embodiment of Figs. 1 and 2 of Claar et al. has a data memory and a data output, but does not have a data input connected to the data memory.

The embodiment of Fig. 3 has a data output but does not appear to have a data memory with the data output and a data input connected thereto.

The embodiment of Fig. 4 has a data output and a data input, but does not appear to have a data memory connected thereto.

Thus, there is no single embodiment of Claar et al. that enables and anticipates the invention of present claim 24. The Examiner seems to be combining features selected from the several embodiments of the reference, without any suggestion to do so. Thus, present independent claim 24 is not anticipated.

- 9) More importantly, some features of claim 24 are not disclosed and would not have been suggested anywhere in the reference.

Particularly, the portable handheld device according to Claar et al. does **NOT** include a data input and output that are configured, arranged and adapted to communicate with both an onboard data processing device of the motor vehicle as well as a data input/output terminal that is external and separate from the motor vehicle.

The embodiment of Fig. 4 of Claar et al. includes a data output (4) and a data input (17). Claar et al. disclose that the output (4) and the input (17) are configured, arranged and adapted to communicate with a control output (A) and a signal input (E') that are connected to a data processing system (8, 16) onboard the motor vehicle. However, Claar et al. do not disclose and would not have suggested that the data input (17) and the data output (4) must additionally be configured, arranged and adapted to communicate with a data input/output terminal that is external and separate from the motor vehicle.

In this regard, the Examiner has asserted that Claar et al. disclose "a terminal conductor external to the vehicle (col. 2, lines 22-64 at least)". It is unclear whether this asserted "terminal conductor" is supposed to correspond to the data input/output terminal recited in present claim 24. More importantly, the reference does not actually disclose such a feature. The cited text portion at col. 2 lines 22 to 64 includes the word "external" at line 23 and line 49. It is assumed that this word "external" generated a "hit" in a keyword search. Nonetheless, the context and meaning is completely different from present claim 24.

Namely, Claar et al. are referring to the charge monitoring device being "external" to the transmitter device. Particularly, the charge state of the battery (3) incorporated in the handheld transmitter device (1) is to be tested and monitored using the receptacle (5) and charge monitoring device (8) that are external to the handheld transmitter device (1) but built into the motor vehicle (see col. 2 lines 22 to 29, 48 to 60).

The disclosure of the reference has nothing to do with data communication between the handheld device and a data input/output terminal that is external and separate from the motor vehicle. Nothing in the reference would have suggested such a data communication between the handheld device and a data terminal that is external and separate from the motor vehicle. Moreover, the reference would have provided no purpose or motivation for configuring and embodying the portable handheld device in a manner so as to provide such a data communication with a data terminal external and separate from the motor vehicle. To the contrary, the only communication according to Claar et al. is between the portable handheld transmitter device (1) and the onboard data processing system (5, DS, 8, 16) of the motor vehicle. There is no disclosure of additionally configuring, arranging and adapting the data input and the data output so as to also communicate with a data terminal external and separate from the motor vehicle.

- 10) For the above reasons, the invention of independent claim 24 is not anticipated and would not have been obvious from the teachings of Claar et al. The dependent claims recite additional features that further distinguish the invention over the prior art, for example as follows.

Regarding present claim 28, Claar et al. do not disclose electronic circuit components integrated on a smart card that is removably received in a recess of a hand grip of a vehicle key. Claar et al. provide no disclosures in this regard. The text (col. 6 lines 45 to 55) referenced by the Examiner has nothing

to do with a smart card removably received in a recess in the hand grip of a key. This text does include the word "card", which would generate a hit in a keyword search, but is actually describing the overall handheld transmitter device (1) being embodied as a card similar to a telephone card that is received in the receptacle (5), as well as means for ejecting the card out of the receptacle. That would have made no suggestion to mount electronic circuit components on a smart card that is removably received in a recess of a hand grip of a vehicle key, for example a key shown in Fig. 4 of the reference (without any smart card removably received therein).

Regarding present claim 40, Claar et al. do not disclose components embodied for transmission according to the Bluetooth specification, contrary to the Examiner's assertion.

In contrast to present claim 41, Claar et al. do not disclose the input or output comprising a signal conductor that is connected to an externally accessible contact terminal to carry out a conductor-bound data exchange. The specific illustrated embodiments of Claar et al. all use an infrared emitting diode (4) or receiver (17) for the transmission, and Claar et al. additionally disclose that the transmission could be carried out by radio or ultrasound signals instead (col. 5 lines 44 to 48). There is no disclosure of a conductor-bound data exchange through a contact terminal. While the transmitter device (1) includes two contact terminals (7) in the embodiment of Figs. 1 and 2, those are not data exchange terminals, but rather are merely voltage terminals connected to the battery (3) for allowing the charge state of the battery to be monitored.

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Present claim 42 is directed to a data exchange system comprising the combination of the portable handheld device, the motor vehicle, and the data terminal that is external and separate from the motor vehicle. As discussed above, Claar et al. do not disclose anything about a data terminal that is external and separate from the motor vehicle. Thus, claim 41 is not anticipated.

Like claim 42, claims 45 to 47 are directed to a data exchange system comprising the combination of the portable handheld device, the motor vehicle with an onboard data processing device, and the data input/output terminal that is external and separate from the motor vehicle. Claar et al. make no suggestions regarding such a combination including an external data terminal that is separate from the motor vehicle.

- 11) For the above reasons, the Examiner is respectfully requested to withdraw the rejection of claims 24 to 27 (28), 29 to 33, 36, 38 to 40 (41, 42) and 45 to 47 as anticipated by Claar et al.
- 12) Referring to pages 3 to 4 of the Office Action, the rejection of claims 34 to 37, 43 and 44 as obvious over Claar et al. in view of US Patent 6,028,537 (Suman et al.) is respectfully traversed.

Claims 34 to 37, 43 and 44 depend from claim 24, which has been discussed above in comparison to Claar et al.

Suman et al. disclose a vehicle communication and remote control system that includes an onboard processor in a motor vehicle, a transceiver coupled to the processor for transmitting and receiving communications from the vehicle to outside services

via a public switched telephone network, and a user interface coupled to the processor for communicating with a user or driver of the vehicle. The outside services can include a computer or data terminal. Various parameters that allow vehicle systems to be personalized to a particular user may be communicated to the onboard vehicle computer through the outside radio communication.

It is significant that the system according to Suman et al. provides a direct transmission from the external data terminal to the onboard computer of the vehicle via a telephone system and a radio communication signal (col. 7 line 17 to col. 8 line 35; col. 36 lines 18 to 30; col. 39 lines 18 to 67; col. 54 line 63 to col. 55 line 67; etc.). The system of Suman et al. also provides for a communication between a key fob or the like and the onboard computer of the motor vehicle (col. 16 lines 16 to 30, col. 20 lines 1 to 30, col. 44 lines 17 to 67). But there is no disclosed communication between the key fob and the external data terminal. For example, it is significant that the programming of the key fob is carried out from the on-board computer of the motor vehicle (col. 19 line 59 to col. 20 line 23).

Thus, there is a direct data communication between the vehicle's on-board computer and the external data terminal, and there is a separate direct communication between a key fob or the like and the onboard computer of the vehicle, but there is no disclosure or suggestion relating to a communication between the external data terminal and the key fob.

In view of the above, just like Claar et al., the disclosure of Suman et al. would have given no suggestion toward the

presently recited feature of independent claim 24, that the data input and the data output of the portable handheld device are configured, arranged and adapted to communicate with both the onboard data processing device of the motor vehicle as well as a data input/output terminal that is external and separate from the motor vehicle. Even a combined consideration of the complete disclosures of the two differences in connection with one another, would thus not have provided any suggestion toward present claim 24.

The dependent claims are patentably distinguishable already in view of their dependence, and recite additional features that further distinguish the invention over the prior art.

Claim 37 further recites that the motor vehicle includes first and second data processing devices, and the data memory of the data exchange device of the portable handheld device includes a first memory area and a second memory area distinct from the first memory area. The first memory area of the handheld device is allocated to the first data processing device of the motor vehicle, and the second memory area of the handheld device is allocated to the second data processing device of the motor vehicle. The Examiner has not addressed these features of claim 37 at all. Also, these features would not have been suggested by the two references taken in combination, because neither one of the references discloses or would have motivated such two distinct memory areas respectively allocated to two different data processing devices onboard a motor vehicle.

Claim 44 is directed to a data exchange system including a combination of the portable handheld device, the motor vehicle, and the external data terminal, and further a computer at a facility of a manufacturer or servicing center for the motor vehicle. This computer is connected to and carries out a data exchange with the data exchange device of the handheld device via the internet and the computer terminal. While it is true that Suman et al. disclose a computer of a vehicle manufacturer or servicing center carrying out a data exchange, that data exchange involves a transmission to the onboard computer of the vehicle itself, and does not involve a data exchange with the portable handheld device.

For the above reasons, the Examiner is respectfully requested to withdraw the rejection of claims 34 to 37, 43 and 44 as obvious over Claar et al. in view of Suman et al.

- 13) New independent claim 48 is based on a combination of prior claims 24 and 37. As such, claim 48 is directed to a portable handheld device including a portable data exchange device with a data memory having first and second distinct memory areas. The first and second memory areas are respectively allocated to and adapted to communicate with separate first and second data processing devices of the motor vehicle. The references are silent in this regard, and the Examiner has not addressed such features. Thus, claim 48 is patentably distinguishable over the prior art.

- 14) Favorable reconsideration and allowance of the application, including all present claims 24 to 48, are respectfully requested.

Respectfully submitted,
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Applicant

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Transmittal Cover Sheet
Credit Card Payment Form

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